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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,146	09/08/2003	Xavier Blin	05725.1239-00	1368

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EXAMINER	
ROGERS, JAMES WILLIAM	
ART UNIT	PAPER NUMBER
1618	

MAIL DATE	DELIVERY MODE
10/09/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/656,146	BLIN ET AL.	
	Examiner	Art Unit	
	JAMES W. ROGERS	1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 July 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-122* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-122* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Applicants amendments to the claims filed 07/28/2008 have been entered. Any rejection from the previous office action filed 04/29/2008 not addressed below has been withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1,7,20,27,33,46,60,66,79,89,95,108 and 115-117 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically claims 1,27,60,89 and 115-117 all recite that the high viscosity phenyl siloxane oil is present in amounts ranging from 5 to 60%, the examiner could not find written support for this new limitation. Paragraph [0047] only states that the amount of phenyl siloxane oil can be from “10 to 60" which does not support the broader range of 5 to 60 as currently claimed. Furthermore claims 7,33,66 and 95 all recite the new limitation the non-volatile ester oil is present in amounts ranging from 5-60%, there is no written support for this new limitation. Paragraph [0067] only states that the amount of hydrocarbon oil can be from “10 to 60" which does not support the broader range of 5 to

60 as currently claimed. Claims 20,46,79 and 108 all recite that the low viscosity phenylsiloxane oil is present in amounts ranging from 5 to 80%, there is no written support for this new limitation. Paragraph [0048] only states that the amount of hydrocarbon oil can be from “7.5” to “80" which does not support the broader range of 5 to 80 as currently claimed.

Response to Arguments

Applicant’s arguments, see Applicant Arguments/Remarks Made in an Amendment, filed 07/28/2008, with respect to the 35 U.S.C. § 102(b) and 102(e) rejections over Arnaud and Agostini have been fully considered and are persuasive, since neither reference teaches an amount of high viscosity phenylsiloxane oil within the claimed range. The 35 U.S.C. § 102(b) and 102(e) rejections over Arnaud and Agostini have been withdrawn.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-122 are rejected under 35 U.S.C. 103(a) as being obvious over Agostini et al. (US 2003/0017124 A1, cited previously), this new rejection was necessitated by applicants amendments to the claims.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in

the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Agostini discloses a two-coat makeup product for the skin, lips or other integuments that contains two compositions. See abstract and [0003]. The second composition includes non-volatile liquids such as hydrocarbon based liquids including diisostearyl malate and high and low viscosity silicone oils that meet applicants claimed high and low viscosity phenylsiloxane. See[0152]-[0202] Regarding the proviso that the composition contains no more than 5% of a volatile oil, the second composition as recited within Agostini only uses a non-volatile solvent, thus it contains essentially no volatile oil. Regarding the limitations that the composition has a post-trial staying power within a certain amount, since the composition of Agostini comprises the same ingredients as applicants it inherently meets the above limitation because the same composition will have the same properties. It appears as though applicants are claiming a new or undiscovered property of an old composition. Where the claimed and prior art

products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case or either anticipation or obviousness has been established, Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). The nonvolatile liquid can comprise from 1% to 100%, preferably 5 to 95%, better still from 20 to 80% and better still 40 to 80% of the total composition. The ratio of the low-viscosity and high viscosity phenylsiloxane oil can range from 70/30 to 30/70, better still from 60/40 to 40/60 and better still from 55/45 to 45/55, within applicants claimed ratio. Thus the amount of high or low viscosity oil could be within applicants claimed range since one of ordinary skill in the art could use from 40-80 wt% of a mixture of phenylsiloxane oils in the cosmetic composition in which 55% percent of the mixture is either high or low viscosity oil, thus the amount of high or low viscosity phenylsiloxane could be anywhere from 22-44% (calculated by taking 0.55x(40-80)). The second composition includes a coloring agent that may also be present in a particulate paste; advantageously the particulate paste is a pigmentary paste. See [0206]-[0242]. The amount of particulate matter within the composition can be from 0.5 to 60, preferably 2 to 40% and most preferably from 3 to 30% of the total composition. The second composition could additionally comprise from 0 to 20% by weight of additives including waxes that are hydrocarbon based, silicone based and/or fluoro based. See [0143] and [0243]-[0248]. Numerous different types of waxes could be selected and include microcrystalline wax, polyethylene wax, silicone waxes made

from alkyl, alkoxy and/or esters of polymethylsiloxane, preferably the amount of wax present is from 3 to 25%. All of the above ranges for the ingredients overlap applicants claimed ranges for the amount of ester oil, rheological agent and particulate phase. One of ordinary skill in the art would have been motivated to adjust the concentrations of oil, rheological agents and particulate matter in order to arrive at a composition with the desired properties through routine and ordinary experimentation. Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages."); In re Hoeschele, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969). Regarding the limitation that the composition is anhydrous Agastini specifically recites that the second composition is advantageously in anhydrous form. See [0255].

Claims 1-122 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnaud et al. (US 5,961,998), for the reasons set forth in the previous office action filed 04/29/2008.

Claims 1-122 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnaud et al. (US 5,961,998) in view of Willemin et al. (US 6,592,855 B1, cited

in previous office action), for the reasons set forth in the previous office action filed 04/29/2008.

Applicant's arguments filed 07/28/2008 have been fully considered but they are not persuasive. Applicants assert that one skilled in the art would not have been motivated to arrive at the claimed invention by selecting one high viscosity phenylsiloxane oil and one non volatile ester oil in combination and Arnaud proved no preference for choosing these particular ingredients.

The relevance of this assertion is unclear. Simply because Arnaud discloses more than one type of phenylsiloxane oil does not mean that the high viscosity phenylsiloxane oils are not disclosed, in fact several of the phenylsiloxane oils are the same oils that applicants list in their specification as having the desired high viscosity such as PCR 15M30. Furthermore the reference clearly discloses that advantageously more than one type of oil is used and the secondary oil includes synthetic esters such as diisostearyl malate. Lastly the same phenylsiloxane oil and ester oil tridecyl trimate are claimed in mixtures or combinations thereof, thus the two oils are within the claimed subject matter of the patent. “The prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed”… *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

Applicants further assert that the tests from the examples within the specification demonstrate the improvement of using high viscosity phenylsiloxane oil in combination with a non-volatile oil ester.

The examiner acknowledges the examples within the specifications, however clearly as recited above Arraund does disclose the use of a phenylsiloxane in combination with an ester that is within applicants claimed scope. It is further noted that applicants examples are much narrower ion scope than what is encompassed within the claims in at least one very specific ester oil and phenylsiloxane were used in the examples (diisostearyl stearate and phenyltrimethyltrisiloxane).

Applicants lastly assert that Arnaud merely discloses laundry list of phenylsiloxanes that may be used in the composition but nowhere states using both a high and low viscosity phenylsiloxane in combination. Applicants also assert that Willemin does not cure these deficiencies of Arnaud.

The examiner as pointed out in the last office action stated that Arnaud does describe some low viscosity phenylsiloxanes such as DC556 and high viscosity phenylsiloxanes such as PCR 15M30. As detailed previously Willemin describes low viscosity phenylsiloxanes were useful in cosmetic compositions. Thus one of ordinary skill in the art could have selected both a high and low viscosity phenylsiloxane oil simply because they were disclosed as being used for the same purpose and the addition would not change the respective functions of the oils within the composition. It is generally considered to be prime facie obvious to combine compounds each of which is taught by the prior art to be useful for the same purpose in order to form a composition that is to be used for an identical purpose. The motivation for combining them flows from their having been used individually in the prior art, and from them being

recognized in the prior art as useful for the same purpose. Cf. In re Kerhoven, 626 F.2d 848, 205 USPQ 1069 (CCPA 1980).

Conclusion

No claims are allowed at this time.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP §706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Rogers, Ph.D. whose telephone number is (571) 272-7838. The examiner can normally be reached on 8:30-5:00.
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on (571) 271-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Michael G. Hartley/

Supervisory Patent Examiner, Art Unit 1618